

### REMARKS

Claims 1, 4-18, and 21-31 are pending in the present application. Claims 2, 3, 19, and 20 are canceled. Claims 1, 18, and 20 are amended to incorporate features originally presented in claims 3 and 20, now canceled. Claims 13, 22, and 31 are amended to correct a typographical error. Reconsideration of the claims is respectfully requested.

#### I. 35 U.S.C. § 101

The Office Action rejects claims 1-12 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Independent claims 1 and 5 are amended to overcome the rejection. To be statutory under 35 U.S.C. § 101, the claimed invention must produce a “useful, concrete and tangible result.” [emphasis added] *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). The invention recited in claims 1 and 4 clearly produces a useful, concrete and tangible result and is in the technological arts, because the invention submits a bid, in a data processing system, for each of a number of order bids based on a final equilibrium price. The invention recited in claims 5-12 clearly produces a useful, concrete and tangible result and is in the technological arts, because the invention sets a price, in a data processing system, for the number of order bids to form a final equilibrium price. One cannot say that the invention recited in claims 1-12, as amended, represents nothing more than an idea or concept, nor is the present invention simply a starting point for future investigation or research.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-12 under 35 U.S.C. § 101.

## II. 35 U.S.C. § 102, Anticipation

The Office Action rejects claims 1, 4-18, and 21-31 under 35 U.S.C. § 102 as being anticipated by *Boarman et al.* (U.S. Patent No. 6,609,112). This rejection is respectfully traversed.

With respect to claim 1, the Office Action states:

As per claim 1, Boarman discloses a method for generating bids for an auction, the method comprising:

identifying a final equilibrium position for a set of bidding agents. (i.e., participants" see column 5 lines 15-35) and submitting. ("i.e., participants system" see column 3 lines 25-45) a bid for each of the bidding agents. (i.e., participants "see column 3 lines 25-30) based on the final equilibrium. (Note abstract and Fig: 3a-3b and see column 3 lines 25-45 and column 5 lines 15-35).

Office Action, dated June 16, 2004. Claim 1 is amended to incorporate subject matter originally presented in claim 3. With respect to claim 3, the Office Action states:

As per claim 3, Boarman discloses, wherein the identifying step comprises:

sorting a plurality of bids by decreasing bid amount to form a sorted set of bids, wherein bids for the set of bidding agents are sorted using upper limits for the, bids for the set of bidding agents. (Note Fig: 3b and see column 5 lines 60-65 and column 6 line 5) identifying a first bid from the plurality of bids in which an unallocatable portion of a requested quantity is present. (see column 6 lines 30-65) selecting a number of bids from the plurality of bids, wherein the number of bids are higher in the sorted set of bids than the first bid and wherein the number of bids have an allocation requirement less than the unallocatable portion of the of the first bid, and setting a price for the number of bids. (Note Fig: 3b and see column 5 lines 60-65 and column 6 line 5 and column 6 lines 30-65).

Office Action, dated June 16, 2004. Applicants respectfully disagree. *Boarman* teaches a system and method for providing proxy-based online Dutch auction services. Bidders provide proxies or bidding agents to submit bids without intervention from the human bidders. The auction manager sorts bids in accordance with proxy values. If a bid is encountered for which the requested quantity is less than or equal to the available quantity, then the bid is accepted and the quantity available value is decremented. If a bid is encountered for which the requested quantity is greater than the available quantity, then the auction manager records a partial bid. See *Boarman*, col. 5, line 56, to col. 6, line 7.

Therefore, in *Boarman*, there will be no bid requesting a quantity for which an unallocatable portion is present. *Boarman* assumes that any allocatable portion will be accepted as a partial bid. This is shown by step 402 in FIG. 3B, where bids are considered until the quantity available equals zero. In *Boarman*, there will be no situation where a bid will be encountered with an unallocatable portion.

In contradistinction, the present invention identifies a bid requesting a quantity for which an unallocatable portion is present and selects a number of order bids, wherein the number of order bids is higher in the sorted set of bids than the identified bid and each bid in the number of order bids has an allocation requirement less than the unallocatable portion of the identified bid. Thus, in the present invention, a bid may be encountered that cannot be filled due to insufficient quantity available. For instance, a bid may request a high quantity, but may accept a low partial quantity. However, if the available quantity is still lower than the low partial quantity, then an unallocatable portion will be left. The present invention then selects remaining bids from the sorted set of bids for which the requested quantity is less than or equal to the unallocatable portion.

The applied prior art does not teach or suggest each and every claim limitation. Therefore, *Boarman* does not anticipate claim 1. Independent claims 5, 13, 18, 22, 30, and 31 recite subject matter addressed above with respect to claim 1 and are allowable for the same reasons. Since claims 4, 6-12, 14-17, 21, and 23-29 depend from claims 1, 5, 13, 18, and 22, the same distinctions between *Boarman* and the invention recited in claims 1, 5, 13, 18, and 22 apply for these claims. Additionally, claims 4, 6-12, 14-17, 21, and 23-29 recite other additional combinations of features not suggested by the reference.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1, 4-18, and 21-31 under 35 U.S.C. § 102.

Furthermore, *Boarman* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Office Action pointing out some teaching or incentive to implement *Boarman* to select bids that request a quantity that is less than an unallocated portion, one of ordinary skill in the art would not be led to modify *Boarman* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify

*Boarman* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

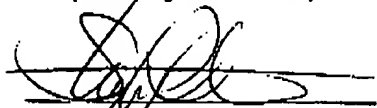
### III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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